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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,907

12/11/2003

Jozef Marie Schaekers

10908/6

8480

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7590

05/08/2006

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/733,907	Applicant(s) SCHAEKERS ET AL.	
	Examiner Joseph D. Anthony	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Foreign Priority

1. Applicant's submission of the English Language Copy of South African Patent Application No. 2001/4794 as originally filed in the Republic of South Africa on 13 June 2001 is acknowledged. A review this document makes clear that there is no support in said foreign priority document for applicant's first extractant of Diagram 1 and Diagram 2, wherein R₂ is a methylene-1-pyrazole group, an imidazole group or a methylene-amino group of Diagram 3 as set forth in the present application S.N. 10/733,907. As such, the effective filing date of the present application is deemed to be the actually filing date of the application which is 12/11/2003.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 513 966 A2 in view of (GB 2 054 543 A or Grinstead U.S. Patent Number 4,254,087 or Lark et al. U.S. Patent Number 4,356,309) and said combination further in view of Dalton U.S. Patent number 5,213,777.

EP teaches extraction composition that comprise: 1) bibenzimidazole of Formula (I) that read on applicant's benzimidazole of Diagram 2 when applicant's R₂ group is an imidazole base group., and 2) an organic solvent, see abstract, pages 1-4, page 6, lines 20-58 and examples 5 to 8. EP differs from applicant's claimed invention in that there is no direct disclosure to the further inclusion of a sulfonic acid as a second extractant, and applicants claimed modifier component.

GB, Grinstead and Lark et al. all teach extraction mixtures for metals that comprise imidazole derivatives extractants in combination with organic sulfonic acid secondary extractants and organic solvents. (see abstract and page 4, line 35 to page 5 line 1 of GB; abstract of Grinstead and abstract and example 2 of Lark et al.)

Dalton teaches extraction mixtures for metals that comprise imidazole derivatives extractants in combination with "modifiers" and organic solvents, see abstract and column 4, lines 35-48.

It would have been obvious to one having ordinary skill in the art to use the direct disclosure of anyone of the secondary references as motivation to actually combined sulphonic acid as secondary extract to the extraction composition taught by EP for the benefits that such would cause. Likewise, it would have been obvious to one having ordinary skill in the art to use the direct disclosure of Dalton as motivation to actually combine a "modifier" to the extraction composition taught by EP for the benefits that such would cause.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states "whoever invents or discovers

Art Unit: 1714

any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of copending Application No. 10/734,090. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Prior-Art Cited But Not Applied

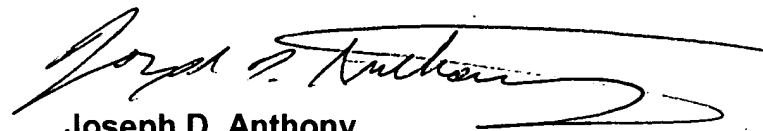
6. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be

Art Unit: 1714

treated as Official communications and cannot be immediately handled by the
Examiner.

A handwritten signature in black ink, appearing to read "Joseph D. Anthony", with a long horizontal flourish extending to the right.

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

5/3/06